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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,859	11/13/2003	Hiromi Ikeda	00862.023317.	6302
5514 7590 02/22/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
			EXAMINER BRINICH, STEPHEN M	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 02/22/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10705859	11/13/03	IKEDA ET AL.	00862.023317.

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

Stephen M. Brinich

ART UNIT	PAPER
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2625

20080212

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Office Action Summary	Application No.		Applicant(s)	
	10/705,859		IKEDA ET AL.	
	Examiner		Art Unit	
	Stephen M. Brinich		2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/13/03, 10/11/07</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 20, while defining a computer program, an algorithm, a medium, a program providing medium, a memory, etc.), does not define a computer-readable medium and is thus non-statutory for that reason. A computer program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on a physical medium of a type that is specifically described in the specification (e.g. the "function expansion board" described on page 22 of the Specification) in order to make the claim statutory.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 17-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 17, lines 1-2, the term "the past settings information" lacks proper antecedent basis.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 14, & 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Shaughnessy et al (US 5075787).

Re claims 1 & 19, Shaughnessy et al (Abstract; column 5, line 66 - column 7, line 9; column 8, lines 30-49 ; Figure 3a) discloses an image processing method and means in which it is

determined whether a read image carries settings information (highlighted instructions determining formatting instructions such as "move this portion of the image", "erase this portion of the image", etc - see column 6, lines 48-67).

Re claims 2-3, Shaughnessy et al discloses (column 8, lines 49-67) the document settings information is based on information added to the read image at a prescribed position (a highlight loop surrounding the specific position of a specific portion of the image to be operated upon).

Re claim 4, Shaughnessy et al discloses (column 8, lines 30-32) that the added information is watermark information (readable under UV illumination).

Re claim 14, the various image portions subjected to the specified processes (moving, erasure, etc) are then synthesized into a final output image.

Re claim 20, Shaughnessy et al discloses that a stored program control (Figure 2, item 36) stores instructions for causing the processing circuitry (readable upon the not further described "computer") to implement this method.

7. Claims 1-3, 5-9, 12, & 15-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Hanson et al (US 6903838).

Re claims 1 & 19, Hanson et al discloses (Abstract; column 3, line 60 - column 4, line 14; column 5, line 60 - column 6, line 2) an image processing method and means in which an identification mark containing settings information is detected (if present) on a document and the settings information is set upon such detection.

Re claims 2-3, Hanson et al discloses (column 3, line 60 - column 4, line 14) that the settings information is placed at a prescribed position in a pre-registered format.

Re claim 5, Hanson et al discloses (column 5, line 62) the use of a bar code as part of the two-dimensional document image to convey the settings information.

Re claims 6-7, Hanson et al discloses (column 5, lines 60-67) the use of settings information containing a destination in the form of an e-mail address to which the document is to be transmitted.

Re claim 8 & 16, Hanson et al discloses (column 5, lines 31-34) the display of this destination.

Re claims 9, 12, & 18, Hanson et al discloses (column 5, lines 31-34) that this displayed destination information may be supplemented or corrected by the user, thereby correcting any

deficiencies present and replacing the old version of this data with a new version.

Re claim 15, Hanson et al discloses (column 5, lines 60-67) the sending of the document to a destination determined by the settings information via one of several means including fax (which inherently includes printing the document at the location contained in the settings information).

Re claim 17, the settings information, which was placed on the document in the past, is selected.

Re claim 20, Hanson et al discloses (column 1, lines 32-40) logic for implementing this arrangement (readable upon the not further specified "control program" for causing a not further specified computer to implement this arrangement).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 10-11 & 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson et al in view of Kaneko et al (US 5577164)

Re claims 10-11 & 13, Hanson et al discloses a display and user editing arrangement for the settings information in which information is input and deficiencies are output and corrected, but does not disclose the use of a voice channel for conveyance of settings information.

Kaneko et al discloses (Abstract; Figure 8) an arrangement for voice input of settings information used to control image processing operations.

Hanson et al and Kaneko et al are combinable because they are from the field of image manipulation in response to user input.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use voice as an information channel for settings information.

The suggestion/motivation for doing so would have been to enable the use of the Hanson et al method and means without the need to physically operate a keyboard or read a display.

Therefore, it would have been obvious to combine Hanson et al with Kaneko et al to obtain the invention as specified in claims 10-11 & 13.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ng et al discloses an additional example of image markup placing settings information on an image.

11. Any inquiry concerning the contents of this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 571-272-7430.

Any inquiry relating to the status of this application, entry of papers into this application, or other any inquiries of a general nature concerning application processing should be directed to the Tech Center 2600 Customer Service center at 571-272-2600 or to the USPTO Contact Center at 800-786-9199 or 571-272-1000.

The examiner can normally be reached on weekdays 8:00-5:30, alternate Fridays off.

The examiner's unit designation has been changed from "Art Unit 2624" to "Technology Division 2625" (as of March 20, 2006).

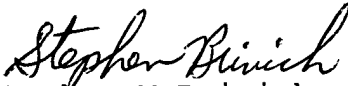
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If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 571-272-7437.

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 571-273-8300.

Hand-carried correspondence may be delivered to the Customer Service Window, located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314.


Stephen M Brinich
Examiner
Technology Division 2625

smb
February 13, 2008